REMARKS / ARGUMENTS

Claims 1-7, 23, 26-32, and 35-42 remain in this application. No claims stand allowed. Claims 8-22, 24-25, and 33-34 have been withdrawn as a result of an earlier restriction requirement.

Claims 37-42 have been added. Claims 37-42 claims are means-plus-function claims corresponding to method claims 2-7.

Claims 5-7, 29-32, and 35-36 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. No "new matter" has been added by the Amendment.

In view of the Examiner's earlier restriction requirement, the Applicants retain the right to present claims 8-22, 24-25, and 33-34 in a divisional application.

The 35 U.S.C. §112 Rejection

Claims 5-7, 30-32, and 36 stand rejected under 35 U.S.C. §112 second paragraph as being allegedly indefinite because they include the trademark name JAVA.[1] With this Amendment, claims 5-7, 30-32, and 36 have been amended to replace the trademark name JAVA with generic language. Accordingly, withdrawal of the 35 U.S.C. §112 second paragraph rejection is respectfully requested.

[1] Office Action dated May 22, 2003 at p. 2 ¶ 2.

The First 35 U.S.C. §103 Rejection

Claims 1, 5-7, 23, 26, 30-32, 35, and 36 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Hawkins[2] in view of Pawlan[3].[4] This rejection is respectfully traversed.

According to M.P.E.P. §2143,

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.[5]

Claim 1

Claim 1 recites:

> A method for executing a dynamically loaded program, said program including a main program unit, said method comprising:
> executing said main program unit a first time;
> creating at least one library file containing only application program files loaded during said first execution of said main program unit;
> specifying a system program file input; and
> executing said main program unit a second time using said system program file input and said at least one library file for dynamically loaded program files.

The Examiner states:

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[2] USP 6,536,035.
[3] *JDK 1.2 Roadmap: All Things new with JDK*, Monica Pawlan, March 1998.
[4] Office Action p. 3 ¶ 2.

In regard to Claim 1, Hawkins teaches: (a) executing a main program unit a first time (Column 8, lines 5 6); (b) creating at least one library file containing application program files loaded during first execution of the main program unit (Column 8, lines 5 12); (c) executing said main program unit a second time using at least one library file for dynamically loaded program files. Hawkins teaches executing the application on a client, and using the library files dynamically (Column 3, lines 4 7). Hawkins does not teach specifying a system program input. Pawlan, however, does teach the Java Development Kit includes libraries of system program files used in the development of Java programs. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to execute a main program unit a first time and create a library file containing application program files loaded during first execution of the main program unit and executing said main program unit a second time using at least one library file for dynamically loaded program files, as taught by Hawkins, where a system program file input is specified and used, as taught by Pawlan, since system files aid in the construction of application programs. Claims 23 and 26 correspond with Claim 1 and are rejected for the same reasons as Claim 1.[6]

The Applicant respectfully disagrees for the reasons set forth below.

I. Hawkins and Pawlan Do Not Teach All Claim Limitations.

When evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.[7]

The Examiner states that Hawkins discloses creating at least one library file containing application program files loaded during a first execution of a program unit. However, claim 1 recites in part

> creating at least one library file containing *only* application program files loaded during said first execution of said main program unit

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[5] *In re Mills*, 916 F. 2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).
[6] Office Action p. 3 ¶ 2.
[7] *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990).

The Examiner has not shown where Hawkins distinguishes between application program files and system program files loaded during the first execution of the main program unit. The Examiner is reminded that the mere absence from a reference of an explicit requirement of a claim cannot be reasonably construed as an affirmative statement that the requirement is in the reference.[8]

For the above reasons, the 35 U.S.C. § 103 rejection is unsupported by the art. Thus, no prima facie case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

II. There Is No Basis in the Art for Combining or Modifying Hawkins

MPEP § 2143 provides:

> The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.[9]

Furthermore,

> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.[10]

Regarding the motivation to combine Hawkins and Pawlan, the Examiner contends:

> ... it would have been obvious to one of ordinary skill in the art at the time of the invention to execute a main program unit a first time and create a library file containing application program files loaded during first execution of the main program unit and executing said main program unit a second time using at least one library file for dynamically loaded program files, as taught by Hawkins, where a system program file

[8] *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987).
[9] *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). (emphasis added)
[10] *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

> input is specified and used, as taught by Pawlan, since system files aid in the construction of application programs.[11]

The Applicants submit the reasons for the combination of references suggested by the Examiner do not constitute particular findings as required by the Federal Circuit. The Federal Circuit has stated:

> The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. ... Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not "evidence."[12]

The Examiner's broad conclusory statement that combining the two references would be obvious because "system files aid in the construction of application programs" standing alone is not evidence.

Moreover, the Applicants respectfully submit that if the first execution produced at least one library file including both application program files *and system program files* loaded during the first execution, there would be no motivation to specify a separate system program file input for the second execution as all the classes required for second execution would be fully specified by the at least one library file produced by the first execution.

[11] Office Action p. 3 ¶ 2.
[12] *In re Kotzab*, 217 F.3d 1370, 55 USPQ2d 1317 (Fed. Cir. 2000) (citations omitted).

For these additional reasons, the 35 U.S.C. § 103 rejection is unsupported by the art. Thus, no prima facie case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

Dependent Claims 5-7

Claims 5-7 depend from claim 1 and thus include the limitations of claim 1. The argument set forth above is equally applicable here. The base claim being allowable, the dependent claims must also be allowable at least for the same reasons.

Claim 35

Claim 35 as amended recites:

> A method for representing a library file, said method including:
> storing in at least one program unit field the pathname of every application program unit loaded during the execution of a dynamically loaded program, said dynamically loaded program including a main program unit; and
> storing in a main unit field the pathname of said main program unit.

The Examiner states:

> In regard to Claim 35, Hawkins teaches storing in at least one program unit field every program unit loaded during execution of a dynamically loaded program (Column 8, lines 5 12). Hawkins does not explicitly teach storing the pathname of every program unit loaded. However, a pathname is an inherent representation of a program unit file. Hawkins also does not specifically teach storing the pathname of the main unit in the main unit field. However, since the main unit is the first program unit to be run, the class file of the main unit will be the first to be loaded, and hence stored in the main program unit during execution. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to store in at least one program unit field every program unit loaded during execution of a dynamically loaded program, where the program unit is stored as a pathname, since a pathname is an inherent representation of a file, and storing a pathname reduces the size of the library file, where the main program unit is stored in the main unit field, since the main program is the first to run, and therefore would be stored in the main unit field.[13]

[13] Office Action p. 4 ¶ 2.

With this Amendment, claim 35 has been amended to specify storing in at least one program unit field the pathname of every *application* program unit loaded during the execution of a dynamically loaded program. This limitation is present in claim 1 and thus the arguments made with respect to claim 1 apply here as well. Claim 1 being allowable, claim 35 must also be allowable.

Dependent Claim 36

Claim 36 depends from claim 35 and thus includes the limitations of claim 35. The argument set forth above is equally applicable here. The base claim being allowable, the dependent claim must also be allowable at least for the same reasons.

Claims 23 and 26

Claims 23 and 26 include limitations similar to claim 1. Thus, the arguments made above with respect to claim 1 apply here as well. Claim 1 being allowable, claims 23 and 26 must also be allowable.

Claims 30-32

Claims 30-32 include limitations similar to claims 5-7, respectively. Thus, the arguments made above with respect to claims 5-7 apply here as well. Claims 5-7 being allowable, claims 30-32 must also be allowable.

The Second 35 U.S.C. §103 Rejection

Claims 2-4 and 27-29 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Hawkins in view of Pawlan and further in view of Weber[14].[15] This rejection is respectfully traversed.

Claims 2-4 depend from independent claim 1. Claims 27-29 depend from independent claim 26. As mentioned above, claims 1 and 26 are not obvious in light of Hawkins and Pawlan. For at least these reasons, dependent claims 2-4 and 27-29 are not obvious in light of Hawkins and Pawlan, and further in light of Weber.

Claim 3

Claim 3 recites:

> The method of claim 2 wherein said storing further comprises:
> loading a program file when referenced during execution of said main program unit;
> storing said program file to said library file *when said program file is an application program file*; and
> determining whether execution of said main program unit has terminated.

The Examiner states:

> In regard to Claim 3, Hawkins teaches: (a) loading a program file when referenced during execution (Column 1, lines 48 57); (b) storing each application program file loaded during execution to a library file (Column 8, lines 5 12). Hawkins does not teach determining whether execution of said main program unit has terminated, however this feature would be obvious, since the method would need to make this determination in order to terminate itself.[16]

The Applicant respectfully disagrees for the reasons set forth below.

[14] *Special Edition Using Java 2 Platform"*, Joseph L. Weber, 1998.
[15] Office Action p. 5 ¶ 3.
[16] Office Action p. 5 ¶ 3.

Claim 3 depends from claim 2. The base claim being allowable, the dependent claim must also be allowable. Furthermore, Hawkins does not teach storing a program file to a library file *when the program file is an application program file* as claimed in claim 3. As mentioned above with respect to claim 1, The Examiner has not shown where Hawkins distinguishes between application program files and system program files loaded during the first execution of the main program unit. The Examiner is reminded that the mere absence from a reference of an explicit requirement of a claim cannot be reasonably construed as an affirmative statement that the requirement is in the reference.[17]

For this additional reason, the 35 U.S.C. § 103 rejection is unsupported by the art. Thus, no prima facie case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

Claims 27-29

Claims 27-29 include limitations similar to claims 2-4, respectively. Thus, the arguments made above with respect to claims 2-4 apply here as well. Claims 2-4 being allowable, claims 27-29 must also be allowable.

Request for Allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

[17] *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987).

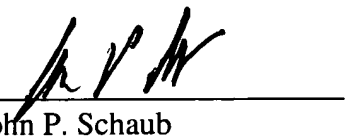
Request for Entry of Amendment

Entry of this Amendment will place the Application either in condition for allowance, or at least, in better form for appeal by narrowing any issues. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,
THELEN REID & PRIEST, LLP

Dated: September 22, 2003



John P. Schaub
Reg. No. 42,125

Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax. (408) 287-8040